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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,076	10/30/2001	Imaddin O. Albazz	CA920000068US1	8347

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EXAMINER

BORISOV, IGOR N

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/004,076	ALBAZZ ET AL.	
<b>Examiner</b>	<b>Art Unit</b>		
Igor Borissov	3629		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 October 2001.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7-12 and 17-20 are rejected under 35 U.S.C. 101 because the claimed method for generating a representation of business policy does not recite a limitation in the technological arts. The independently claimed steps of: storing at least one compilation of business rules; storing at least one policy set containing parameters corresponding to selected rules; generating links between the compilation of business rules and the policy set to generate specific rules to be embodied in the business contract; interlocking the compilation of business rules, the policy set and the links, are abstract ideas which can be performed mentally without interaction of a physical structure. Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 6-7, 12-15 and 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Arnold et al. (US 5,987,423).

Arnold et al. teach a method and system for object oriented technology framework for order processing, comprising:

As per claims 1, 6, 7, 12-13, 15, 17 and 19,

storing at least one compilation of business rules comprising a plurality of rules available to be selected for inclusion in a business contract (column 15, lines 26-49; column 16, line 48 – column 17, line 16; column 19, line 34 – column 20, line 10);

storing at least one policy set containing parameters corresponding to selected rules from the compilation of business rules (column 15, lines 26-49; column 16, line 48 – column 17, line 16; column 19, line 34 – column 20, line 10);

generating links between the compilation of business rules and the policy set to generate specific rules to be embodied in the business contract (column 12, line 48 – column 13, line 45; column 14, lines 54-65; column 16, line 48 – column 17, line 16);

interlocking the compilation of business rules, the policy set and the links (column 12, line 48 – column 13, line 45; column 14, lines 54-65; column 16, line 48 – column 17, line 16; column 22, lines 52-56).

As per claims 14 and 18, generating at least one document processed according to the business rules in the business contract (column 13, line 55 – column 14, line 3).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3629

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5, 8-11, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold et al. (US 5,987,423).

As per claims 2-3, 8-9, 16 and 20, Arnold et al. teach said method and system, comprising:

storing at least one product aspects that are unique to purchase orders for generating a list of a specified subset of products from a more general purchase product class (column 16, lines 48-58);

generating links between the list of a specified subset of products, the policy set and the purchase product class (column 16, line 48 – column 17, line 16).

Arnold et al. do not specifically teach that generating a list of a specified subset of products includes storing a product list filter for generating said list of said subset of products.

It would have been an obvious matter of design choice to modify Arnold et al. to include generating a list of a specified subset of products includes storing a product list filter for generating said list of said subset of products, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of Arnold et al. would perform the invention as claimed by the applicant either with or without said storing a product list filter.

As per claims 4-5 and 10-11, Arnold et al. teach said method and system,

wherein the business contract comprises dynamic elements, which can be altered without modifying the business contract (column 12, line 48 – column 13, line 45; column 14, lines 54-65; column 16, line 48 – column 17, line 16).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

**(703) 305-7687** [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

*DB*

*John G. Weiss*  
JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
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